

## **REMARKS**

Reconsideration and allowance of the claims are requested in view of the above amendments and the following remarks. Claims 1, 14 and 63 have been amended. Support for the claim amendments may be found in the specification and claims as originally filed. For example, support for the claim amendments may be found in the present specification at least at paragraph 7, lines 1-2; paragraph 44; and the abstract, lines 1-3 and 7-9. No new matter has been added.

Claims 7, 15-62 and 66-83 have been canceled without prejudice or disclaimer.

Upon entry of this amendment, claims 1-6, 8-14 and 63-65 are pending with claims 1, 14 and 63 being independent.

Applicants thank Examiner Nguyen for the courtesies extended to applicants' representative, Mr. Sung Kim, during a telephonic interview conducted on March 13, 2009. The substance of the interview is incorporated in the following remarks.

### **1. Rejections Under 35 U.S.C. §103**

#### **A. Rejections Based on Kaker et al. and Capps**

The Office Action rejects claims 1-6, 8-14 and 63-64 under 35 U.S.C. §103(a) as being unpatentable over Kaker et al. (2001/0037218) in view of Capps (5,666,502). Applicants respectfully traverse this rejection for at least the following reasons.

As discussed during the interview, the rejection of claims 1 and 14 on pages 2-3 of the Office Action appears to be based on the prior version of the claims, instead of the current version of the claims, which were amended in the "Amendment & Response to Final Office Action Mailed 5/30/08" filed on 10/30/08. For example, the Office Action on pages 2-3 fails to provide any explanation for how Kaker et al. in view of Capps teaches at least the following elements of independent claims 1 and 14, respectively (emphasis added):

1. A computer-implemented method, comprising:

...

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receiving input from the user to set the context of a selected operable field;

in response to the context set by the user, displaying to the user the availability of the one or more actions for formatting data in the selected operable field of the electronic form; and

after displaying the availability of the one or more actions, enabling the user to format data, based on the availability of the one or more actions, in the selected operable field of the electronic form.

14. One or more computer-readable storage media having stored thereon a plurality of computer-executable instructions performing steps comprising:

...

receiving input from the user to set the context of a selected operable field;

in response to the context set by the user, displaying to the user the availability of the one or more actions for formatting data in the selected operable field of the electronic form; and

after displaying the availability of the one or more actions, enabling the user to format data, based on the availability of the one or more actions, in the selected operable field of the electronic form.

Similarly, the Office Action fails to provide any explanation for how Kaker et al. in view of Capps teaches at least the following elements of independent claim 63 (emphasis added):

63. An apparatus comprising:

...

means for receiving input from a user to set the context of a selected operable field;

means for displaying, in response to the context set by the user, the availability of the one or more actions to the user for formatting data in the selected operable field of the electronic form;

means for, after displaying the availability of the one or more actions, enabling the user to format data, based on the availability of the one or more actions, in the selected operable field of the electronic form; . . .

**Therefore, applicants respectfully request an examination of the current version of the**

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**claims.**

Additionally, the Office Action on page 2 asserts that Kaker et al. discloses discovering/deploying, without user interaction, a solution (citing paragraph 125). Applicants disagree.

Kaker et al. discloses an online system for providing prescription assistance for indigent patients using programs provided by pharmaceutical manufacturers (see abstract). Kaker et al. states in paragraph 125 (emphasis added):

The Prescription Form Page 56 may be accessed by clicking the appropriate hyperlinked text statement on the Auto Fill Page 38. The request forwarded to the web server includes parameters specifying all of the information recorded in the Prescription Form on the Auto Fill Page 38. The server redirects the user to a PDF file that stores a copy of the manufacturer's Fill-In Form which is automatically filled with the appropriate data from the Prescription Form. A suitable software, such as the Adobe Acrobat, Adobe Systems, Inc., must be used by the user in order to view the form 58, edit the content that was autofilled and print it. The user can then complete the form (with signature, if required) and send it to the appropriate location.

Therefore, Kaker et al. requires that suitable software must be obtained and used by a user in order to view, edit and print the manufacturer's Fill-In Form. As discussed during the interview, this is in stark contrast to discovering a solution or deploying the solution without user interaction. As discussed in the present specification in paragraph 28 (emphasis added)

. . . If a user has opened the data file first online, or if the system has otherwise received the data file's solution, an electronic forms application can silently discover and deploy the data file's solution. The data file's solution declaratively defines aspects of the data file such as its elements, attributes, and values, as will be discussed below. The electronic forms application allows a user to simply select a data file to open and the electronic forms application will open the data file with a discovered and deployed solution. The user need not discover, select, or even be aware that the data file requires a solution for the data file to be edited. After selecting the data file to open, the user can then edit and access the data file in a

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way very similar to how it would act and appear had the user opened the data file while online.

Therefore, Kaker et al. fails to teach or suggest at least the following elements of independent claims 1, 14 and 63, respectively (emphasis added):

1. A computer-implemented method, comprising:

...  
discovering, without user interaction, a solution, the solution defining an availability of one or more actions for formatting data in one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;

deploying, without user interaction, the solution;  
displaying, to the user, by opening the data file with the solution, the electronic form having the one or more operable fields; ...

14. One or more computer-readable storage media having stored thereon a plurality of computer-executable instructions performing steps comprising:

...  
discovering, without user interaction, a solution, the solution defining an availability of one or more actions for formatting data in one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;

deploying, without user interaction, the solution;  
displaying, to the user, by opening the data file with the solution, the electronic form having the one or more operable fields; ...

63. An apparatus comprising:

...  
means for selecting the data file;  
means for discovering and deploying, without user interaction, a solution governing the data file, wherein the solution defines an availability of one or more actions for formatting data in

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one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;  
means for displaying the electronic form representing a product of the solution and the data file, wherein the electronic form comprises the one or more operable fields; . . .

Furthermore, the Office Action concedes that Kaker et al. does not explicitly disclose defining the availability of one or more actions to the user when entering the data into each operable field of the electronic form. However, the Office Action asserts that Capps teaches these features (citing Fig. 5B and 13A-14C; col. 10, line 45 – col. 11, line 14; col. 12, lines 51-53; col. 16, line 23 – col. 17, line 7).

Capps discloses a form having a name label 182 for a name field 184 and other labels and fields, as well as history list indicators 186 and 187. A user can input data into the name field 184 as well as the other fields. When the user seeks to enter data into the name field 184, the user can click, tap or otherwise select the history list indicator 186 to obtain a history list for names (see col. 10, lines 45-63; Figs. 5A-5B; similar descriptions found at col. 12, lines 51-53, col. 16, line 23 – col. 17, line 7, and Figs. 13A-14C). The history list can include an “other” region 201 to allow the user to select an input from a larger conventional styled list of choices when the items within the history list do not include the value needed by the user (see col. 11, lines 7-11).

Therefore, Capps at most teaches a history list that may include names or other types of static data that may be selected by a user. However, Capps fails to teach a solution defining an availability of one or more actions for formatting data in a field of an electronic form. In embodiments of the present application, these actions can be specified in a solution so as to provide a user with a word processor-like data entry experience when using an electronic form, including the formatting and editing of data in fields of the electronic form (see present specification, paragraph 7). For example, the present specification discusses examples of actions in at least paragraph 44 (emphasis added):

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. . . The selected action might also be a feature rich editing operation with respect to data in one of the data-entry fields, where the editing operation can be an undo function, a redo function, a copy function, a cut function, a paste function, an insertion of a hyperlink, a carriage return, or line feed function. The action that the user selects at block 308 can also be the performance of a character formatting operation with respect to data in one of the data-entry fields. Such a character formatting operation can be characterized as boldface, italics, underlining, a change of font size or font color, character spacing, or text effects. The action selected can also be adding, entering, updating or deleting, with respect to one of the data-entry fields, a repeating operable field, an optional operable field, a spreadsheet, a table, a row or a column in a table, a text box, multiple spaces, a header, a footer, an image, a graphic, a picture, a link to an image, a link to a graphic, a link to a picture, single line plain text, multi-line plain text, single line formatted text, multi-line formatted text, rich text, a whole number, a decimal, a true/false distinction, a date, or a time. . .

Also, as discussed during the interview, since Capps fails to teach or suggest the features of a solution defining an availability of one or more actions for formatting data in one or more operable fields of an electronic form, Capps necessarily also fails to teach that the availability of one or more actions for formatting data is defined for each one of the one or more operable fields.

As a result, Capps fails to teach or suggest at least the following elements of independent claims 1, 14 and 63, respectively (emphasis added):

1. A computer-implemented method, comprising:

. . .  
discovering, without user interaction, a solution, the solution defining an availability of one or more actions for formatting data in one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;

14. One or more computer-readable storage media having stored thereon a plurality of computer-executable instructions performing steps comprising:

...  
discovering, without user interaction, a solution, the solution defining an availability of one or more actions for formatting data in one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;

63. An apparatus comprising:

...  
means for selecting the data file;  
means for discovering and deploying, without user interaction, a solution governing the data file, wherein the solution defines an availability of one or more actions for formatting data in one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;

Therefore, since Kaker et al. and Capps, alone or in combination, fail to disclose or suggest all of the elements of independent claims 1, 14 and 63, these claims are allowable.

Claims 2-6 and 8-13 depend from claim 1. Claim 64 depends from claim 63. As discussed above, claims 1 and 63 are allowable. For at least this reason, and the additional features recited therein, claims 2-6, 8-13 and 64 are also allowable.

For at least the reasons above, reconsideration and withdrawal of the rejection of claims 1-6, 8-14 and 63-64 under 35 U.S.C. §103(a) are respectfully requested.

#### **B. Rejections Based on Kaker et al., Capps and Turpin**

The Office Action rejects claim 65 under 35 U.S.C. §103(a) as being unpatentable over Kaker et al. in view of Capps and further in view of Turpin (5,640,501). Applicants respectfully traverse this rejection for at least the following reasons.

As discussed above, Kaker et al. and Capps, alone or in combination, fail to disclose or

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suggest all of the elements of independent claim 63. Turpin fails to cure this defect.

Turpin is cited by the Office Action primarily for its teaching of various editing and formatting operations (citing Fig. 6; col. 16, line 46 – col. 17, line 46). However, Turpin fails to teach or suggest at least the elements discussed above with respect to claim 63.

Therefore, since Kaker et al., Capps and Turpin, alone or in combination, fail to disclose or suggest all of the elements of independent claim 63, this claim is allowable.

Claim 65 depends from claim 63. As discussed above, claim 63 is allowable. For at least this reason, and the additional features recited therein, claim 65 is also allowable.

For at least the reasons above, reconsideration and withdrawal of the rejection of claim 65 under 35 U.S.C. §103(a) are respectfully requested.

## **2. Conclusion**

Accordingly, in view of the above amendment and remarks it is submitted that the claims are patentably distinct over the cited art and that all the rejections to the claims have been overcome. Reconsideration and reexamination of the present application is requested. Based on the foregoing, applicants respectfully request that the pending claims be allowed, and that a timely Notice of Allowance be issued in this case. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the applicants' attorney at the telephone number listed below.

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If this response is not considered timely filed and if a request for an extension of time is otherwise absent, applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee that is not covered by an enclosed check please charge any deficiency to Deposit Account No. 50-0463.

Respectfully submitted,  
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Date: March 16, 2009

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/Noemi Tovar/  
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